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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92048777
Party	Defendant Michael Calmese
Correspondence Address	MICHAEL CALMESE 3046 N 32ND ST UNIT 321 PHOENIX, AZ 85018-6842 UNITED STATES proveit@excite.com
Submission	Other Motions/Papers
Filer's Name	Michael Calmese
Filer's e-mail	proveit@excite.com
Signature	/Michael Calmese/
Date	12/28/2010
Attachments	TTAB_dec_28_doc.pdf ( 2 pages )(63317 bytes ) Order on Plaintiff's Motion for Summary Judgment MSJ Order.pdf ( 26 pages )(63468 bytes ) adidas v. Calmese - 08-CV-91 - Verdict FoF CoL TP 11.17.10.pdf ( 15 pages )(25415 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Adidas America, Inc., a Delaware Corporation,	)	
Petitioner,	)	Cancellation No.: 92048777
	)	Registration No.: 2,202,454
-against-	)	Registration Date: November 10, 1998
	)	Mark: <b>PROVE IT!</b>
Michael D. Calmese, a resident of Arizona,	)	
Respondent	)	
_____	)	

**PLEASE TAKE NOTICE**, pursuant to the Board's Order dated December 23, 2010, attached are true and accurate copies of the Oregon District Court's (1) Order on Plaintiff's Motion for Summary Judgment, (2) Findings of Fact Conclusion of Law for the matter entitled adidas America Inc., v. Michael D. Calmese.

RESPECTFULLY SUBMITTED this 28<sup>th</sup> day of December, 2010

s/Michael D. Calmese/  
\_\_\_\_\_  
Michael Calmese  
Attorney Pro Se  
3046 N. 32<sup>nd</sup> Street Unit 321  
Phoenix, Az 85018  
[www.usaproveit.com](http://www.usaproveit.com)  
(602)954-9518

## CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing was forwarded on this the 28<sup>th</sup> day of December, 2010, addressed as follows:

Stephen M. Feldman, OSB No. 932674  
SFeldman@perkinscoie.com  
PERKINS COIE LLP  
1120 N.W. Couch Street, Tenth Floor  
Portland, OR 97209-4128  
Telephone: 503.727.2000  
Facsimile: 503.727.2222

And

David K. Friedland (admitted *pro hac vice*)  
dkfriedland@lfiplaw.com  
Jaime S. Rich (admitted *pro hac vice*)  
jrich@lfiplaw.com  
Lott & Friedland, P.A.  
355 Alhambra Circle, Suite 1100  
Coral Gables, FL 33134  
Telephone: 305.448-7089  
Facsimile: 305.446-6191

Attorneys for Plaintiff and Counterclaim Defendant

s/Michael D. Calmese/  
Michael D. Calmese

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF OREGON

ADIDAS AMERICA, INC.,

08-CV-91-ST

Plaintiff,

ORDER

v.

MICHAEL CALMESE,

Defendant.

DAVID K. FRIEDLAND

JAIME S. RICH

Lott & Freidland, P.A.  
355 Alhambra Circle, Suite 1100  
Coral Gables, FL 33134  
(305) 448-7089

STEPHAN M. FELDMAN

Perkins Coie, LLP  
1120 N.W. Couch St., 10th Floor  
Portland, OR 97209  
(503) 727-2058

Attorneys for Plaintiff

**MICHAEL CALMESE**

3046 N. 32nd Street, Unit 321  
Phoenix, AZ 85018  
(602) 954-9518

Defendant, *Pro Se*

**BROWN, Judge.**

On July 8, 2009, Magistrate Judge Janice M. Stewart issued Amended Findings and Recommendation (#101) in which she recommended this Court (1) grant the Motion (#42) for Summary Judgment of Plaintiff adidas America, Inc., as to Plaintiff's First Cause of Action for a declaratory judgment for noninfringement of the registered trademark "prove it!"; (2) grant Plaintiff's Motion as to Defendant's Counterclaim for trademark infringement; (3) grant Plaintiff's Motion as to Defendant's Counterclaim for violations of Oregon Unlawful Trade Practices Act (OUTPA), Or. Rev. Stat. § 646.605, *et seq.*; (4) deny Plaintiff's Motion as to its affirmative defense of fair use to Defendant's Counterclaim; (5) deny Plaintiff's Motion as to its Second Cause of Action for a declaration that Plaintiff's use of the registered trademark "prove-it!" is not a false designation of origin; and (6) deny Plaintiff's Motion as to its Third Cause of Action for cancellation of trademark registration.

Both Plaintiff and Defendant filed Objections to the Magistrate Judge's Amended Findings and Recommendation.

On August 17, 2009, the Magistrate Judge also issued an Opinion and Order (#115), a nondispositive order, denying

Defendant's Motion (#103) for Leave to Amend Opposition and File Motion to Dismiss. The Court, as discussed below, construes Defendant's August 27, 2009, letter as a timely objection to the Magistrate Judge's Opinion and Order.

These matters are now before this Court pursuant to 28 U.S.C. § 636(b)(1) and Federal Rule of Civil Procedure 72 (a) and (b).

When any party objects to any portion of the Magistrate Judge's Findings and Recommendation or any portion of a Magistrate Judge's nondispositive Order, the district court must make a *de novo* determination of that portion of the Magistrate Judge's report or order. 28 U.S.C. § 636(b)(1). *See also United States v. Reyna-Tapia*, 328 F.3d 1114, 1121 (9th Cir. 2003)(*en banc*); *United States v. Bernhardt*, 840 F.2d 1441, 1444 (9th Cir. 1988).

This Court is relieved of its obligation to review the record *de novo* as to those portions of the Findings and Recommendations that were not objected to by the parties. *Britt v. Simi Valley Unified School Dist.*, 708 F.2d 452, 454 (9th Cir. 1983)(rev'd on other grounds). *See also Lorin Corp. v. Goto & Co.*, 700 F.2d 1202, 1206 (8th Cir. 1983). Having reviewed *de novo* the legal principles of those portions of the Findings and Recommendations that were not objected to by the parties, the Court does not find any error.

STANDARDS**I. Summary Judgment.**

Federal Rule of Civil Procedure 56(c) authorizes summary judgment if no genuine issue exists regarding any material fact and the moving party is entitled to judgment as a matter of law. The moving party must show the absence of an issue of material fact. *Rivera v. Philip Morris, Inc.*, 395 F.3d 1142, 1146 (9th Cir. 2005). In response to a properly supported motion for summary judgment, the nonmoving party must go beyond the pleadings and show there is a genuine issue of material fact for trial. *Id.*

An issue of fact is genuine "'if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.'" *Villiarimo v. Aloha Island Air, Inc.*, 281 F.3d 1054, 1061 (9th Cir. 2002)(quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)). The court must draw all reasonable inferences in favor of the nonmoving party. *Id.* "Summary judgment cannot be granted where contrary inferences may be drawn from the evidence as to material issues." *Easter v. Am. W. Fin.*, 381 F.3d 948, 957 (9th Cir. 2004)(citing *Sherman Oaks Med. Arts Ctr., Ltd. v. Carpenters Local Union No. 1936*, 680 F.2d 594, 598 (9th Cir. 1982)).

A mere disagreement about a material issue of fact, however, does not preclude summary judgment. *Jackson v. Bank of*

*Haw.*, 902 F.2d 1385, 1389 (9th Cir. 1990). When the nonmoving party's claims are factually implausible, that party must "come forward with more persuasive evidence than otherwise would be necessary." *Wong v. Regents of Univ. of Cal.*, 379 F.3d 1097 (9th Cir. 2004), as amended by 410 F.3d 1052, 1055 (9th Cir. 2005)(citing *Blue Ridge Ins. Co. v. Stanewich*, 142 F.3d 1145, 1149 (9th Cir. 1998)).

The substantive law governing a claim or a defense determines whether a fact is material. *Miller v. Glenn Miller Prod., Inc.*, 454 F.3d 975, 987 (9th Cir. 2006). If the resolution of a factual dispute would not affect the outcome of the claim, the court may grant summary judgment. *Id.*

## **II. Trademark infringement.**

"A successful trademark infringement claim . . . requires a showing that the claimant holds a protectable mark, and that the alleged infringer's imitating mark is similar enough to 'cause confusion, or to cause mistake, or to deceive.'" *Survivor Media, Inc. v. Survivor Prod.*, 406 F.3d 625, 630 (9th Cir. 2005)(quoting *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 116 (2004)). "The critical determination is 'whether an alleged trademark infringer's use of a mark creates a likelihood that the consuming public will be confused as to who makes what product.'" *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 632 (9th Cir. 2008)(quoting *Brother Records Inc. v. Jardine*,



318 F.3d 900, 908 (9th Cir. 2003)).

The Ninth Circuit employs the following eight-factor test (*Sleekcraft* factors) to determine the likelihood of confusion: "(1) strength of the mark; (2) proximity or relatedness of the goods; (3) similarity of sight, sound and meaning; (4) evidence of actual confusion; (5) marketing channels; (6) type of goods and purchaser care; (7) intent; and (8) likelihood of expansion." *Jada Toys*, 518 F.3d at 632 (quoting *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979)). "The factors should not be rigidly weighed, but are only intended to guide the court." *Dreamwerks Prod. Group, Inc.*, 142 F.3d at 1129 (citing *Sleekcraft*, 599 F.2d at 348-49). In addition, "the test for likelihood of confusion is 'pliant,' and 'some factors are much more important than others.'" *Jada Toys*, 518 F.3d at 632 (quoting *Brookfield Commc'n, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1053-54 (9th Cir. 1999)).

### DISCUSSION

#### **I. Plaintiff's Objections to the Magistrate Judge's Findings and Recommendation.**

Plaintiff contends the Magistrate Judge erred when she (1) recommended this Court deny summary judgment to Plaintiff as to its claim for a declaration of non-false designation of origin and (2) found two of the *Sleekcraft* factors favor Defendant.

**A. Plaintiff's claim for non-false designation of origin.**

Plaintiff contends the Magistrate Judge erred when she recommended this Court deny summary judgment to Plaintiff as to its claim for a declaration of non-false designation of origin on the ground that the recommendation is inconsistent with the Magistrate Judge's recommendation that this Court grant summary judgment to Plaintiff on its claim of trademark noninfringement.

15 U.S.C. § 1125(a) provides:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any . . . false designation of origin . . ., which . . . is likely to cause confusion . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

The test for whether trademark infringement has occurred is identical to the test for whether false designation of origin has occurred. *Jada Toys*, 518 F.3d at 632. *See also Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1178 (9th Cir. 1988); *Brookfield*, 174 F.3d at 1046.

Although the Magistrate Judge did not separately address Plaintiff's claim for a declaration of non-false designation of origin, she did address whether a likelihood of confusion existed between the use of the phrase "prove it" on Plaintiff's t-shirts and Defendant's "prove it!" trademark. As noted, after considering each of the *Sleekcraft* factors, the Magistrate Judge found two were neutral, four weighed in favor of Plaintiff, and

two weighed in favor of Defendant. The Magistrate Judge found the factors that were most important were the ones favoring Plaintiff; namely, lack of strength of Defendant's mark, the lack of relatedness of the goods, the lack of similarity of the marks, and the lack of evidence of actual confusion. Accordingly, the Magistrate Judge concluded there was not any triable issue of fact as to the likelihood of confusion between the two marks.

After reviewing the pertinent portions of the record *de novo* and Plaintiff's Objections, the Court notes the *Sleekcraft* factors found by the Magistrate Judge to favor Plaintiff also are at the heart of the test for non-false designation of origin, and, therefore, the Court finds the Magistrate Judge erred when she denied summary judgment to Plaintiff on its claim for a declaration of non-false designation of origin.

**B. *Sleekcraft* factors of similarity of marketing channels and good faith.**

Plaintiff contends the Magistrate Judge erred when she found the *Sleekcraft* factors regarding similarity of marketing channels and good faith weighed in Defendant's favor even though the findings do not change the outcome of the Magistrate Judge's decision, because, as noted, the Magistrate Judge found the *Sleekcraft* factors in favor of Plaintiff outweighed the factors in favor of Defendant.

**1. Similarity of marketing channels.**

Although Plaintiff contends both parties rely on word-of-mouth, Internet sites, sports-related retail stores, and the sponsorship of professional athletes and teams, the only overlap that exists between its marketing channels and those of Defendant are primarily in the Phoenix, Arizona, area, and, therefore, Plaintiff contends this factor should weigh in its favor. Under *Surfvivor*, however, this factor weighs in favor of Defendant despite the fact that the geographic overlap in their marketing channels is minor. See 406 F.3d at 634 (factor weighed in favor of the party whose products were primarily marketed in a single state).

The Magistrate Judge, viewing all of the facts in the light most favorable to Defendant as the nonmoving party, noted the parties had achieved differing degrees of success in their marketing, but both parties were essentially operating within the same marketing channels, and, therefore, this factor weighs in Defendant's favor.

After reviewing the pertinent portions of the record *de novo* and Plaintiff's Objections, the Court agrees with the Magistrate Judge. Accordingly, the Court does not find any error in the Magistrate Judge's Amended Findings and Recommendation as to this factor.

## **2. Good faith.**

This factor weighs against an alleged infringer who

employs a mark with actual or constructive knowledge of its trademarked status. *Surfvivor*, 406 F.3d at 634. Plaintiff contends there is not any evidence that it acted in bad faith when it used the phrase "prove it" on its merchandise. "'[W]here the alleged infringer[, however,] adopted his mark with knowledge, actual or constructive, that it was another's trademark,' resolution of this factor favors [the holder of the mark]." *Surfvivor*, 406 F.3d at 634 (quoting *Brookfield*, 174 F.3d at 1059).

The Magistrate Judge, viewing all of the facts in the light most favorable to Defendant as the nonmoving party, found Plaintiff acted with actual or constructive knowledge of the existence of Defendant's trademark when it used the "prove it" phrase on its merchandise because a simple trademark search would have revealed it was Defendant's trademark and because Defendant at one point contacted Plaintiff regarding a co-sponsorship with Reebok.

After reviewing the pertinent portions of the record *de novo* and Plaintiff's Objections, the Court agrees with the Magistrate Judge. Accordingly, the Court does not find any error in the Magistrate Judge's Amended Findings and Recommendation as to this factor.

## **II. Defendant's Objections to the Magistrate Judge's Amended Findings and Recommendation.**

Defendant contends the Magistrate Judge erred by

(1) concluding certain *Skillcraft* factors did not weigh in Defendant's favor and, as a result, granting summary judgment to Plaintiff as to its claim for a declaration of trademark noninfringement and as to Defendant's Counterclaim of trademark infringement and (2) granting summary judgment to Plaintiff as to Defendant's Counterclaim for violations of OUTPA.

**A. Timeliness of Defendant's Objections.**

Plaintiff contends this Court should strike Defendant's Objections to the Magistrate Judge's Amended Findings and Recommendation because the Objections were not timely filed. Defendant, however, asserts he timely filed his Objections to the Amended Findings and Recommendation because he mailed them on July 20, 2009. Defendant has offered a photocopy of his receipt to demonstrate the date he mailed his Objections.

Unlike service on other parties, which may be effective upon placing the document in the mail, a filing with the Court does not occur until the document is received by the Clerk of Court. Fed. R. Civ. P. 5(d)(2). *See also Ordonez v. Johnson*, 254 F.3d 814, 816 (9th Cir. 2001)(a complaint is filed when it is received by the clerk); *McClellon v. Lone Star Gas Co.*, 66 F.3d 98, 101 (5th Cir. 1995)("[A] pleading is considered filed when placed in the possession of the clerk of court."). The court has discretion to strike a late filing. *Rodriguez v. West Publ'g Corp.*, 563 F.3d 948, 967 (9th Cir. 2009)(citing *United States v.*

*W.R. Grace*, 526 F.3d 499, 508-09 (9th Cir. 2008)(*en banc*)).

The record reflects Objections to the Amended Findings and Recommendation were due on July 20, 2009, but Defendant's Objections were not received by the Clerk of Court until July 22, 2009. Accordingly, Defendant's Objections to the Amended Findings and Recommendation were not timely.

Although the Court agrees Defendant's Objections, nevertheless, fail to provide a basis for not adopting the Magistrate Judge's Amended Findings and Recommendation as discussed below. Accordingly, in the exercise of its discretion, the Court concludes it is appropriate to consider the merits of Defendant's Objections.

**B. The Magistrate Judge's findings as to the *Skillcraft* factors that were neutral or favored Plaintiff.**

Defendant objects to the Magistrate Judge's findings that six of the *Skillcraft* factors were neutral or weighed in favor of Plaintiff on the ground that Defendant's attorney, who has since withdrawn, had an alleged conflict of interest that resulted in his failure to file several exhibits in response to Plaintiff's summary-judgment motion. Defendant asserts his attorney failed to file Exhibits A-J and Exhibits O and P, all of which are attached to Defendant's Objections. The Court notes, however, that Defendant's Exhibits B, D, E, F, G, O, and P are all attached to the Supplemental Declaration of Jaime S. Rich, which was part of the record before the Magistrate Judge. In addition,

Exhibits H and I are attached to Defendant's Answer. Thus, all of the exhibits with the exception of Exhibit A, part of Exhibit C, and Exhibit J were part of the record before the Magistrate Judge. Accordingly, any failure on the part of Defendant's attorney to refile those exhibits was harmless.

With respect to Exhibit A, the Court notes it consists of the Affidavits of Karen Maldenado, Susan Badger, and Ray Maxxy, who each state they experienced actual confusion with respect to the parties' products. As noted, Exhibit A was not part of the record before the Magistrate Judge on summary judgment.

Exhibit C, consisting of Bank of America Statements from September 2003 to December 2007 is only partly represented in the Supplemental Declaration of Jaime S. Rich, which includes only bank records from 2005. Defendant's Exhibit J is the Magistrate Judge's Order on the Motion to Withdraw as Counsel of Record, which the Court notes could not have been filed by Defendant's attorney or considered by the Magistrate Judge when resolving Plaintiff's summary-judgment motion because Defendant's counsel withdrew after Plaintiff's summary-judgment motion was fully briefed. In addition, Exhibit J does not address the *Skillcraft* factors.

Nevertheless, although Defendant contends the Magistrate Judge would have concluded all of the *Skillcraft* factors weighed in Defendant's favor if his attorney had filed the documents in



question, Defendant does not argue the Magistrate Judge's findings with respect to the *Skillcraft* factors were erroneous on the record that was before her.

Plaintiff, in turn, argues all of the documents produced by Defendant in discovery were included as attachments to the Supplemental Declaration of Jaime S. Rich. Plaintiff contends Exhibit A (the Affidavits of Maldenado, Badger, and Maxxy) and Exhibit C (the 2003-07 bank records) are inadmissible in any event because Defendant failed to produce them in discovery. In fact, Plaintiff maintains the first time it saw Exhibit A and all of Exhibit C is when it received Defendant's Objections to the Magistrate Judge's Amended Findings and Recommendation. Plaintiff points out that the Court may exclude evidence that a party failed to produce during discovery. *See Zhang v. Am. Gem Seafoods, Inc.*, 339 F.3d 1020, 1028 (9th Cir. 2003).

Defendant does not dispute Exhibits A and C were not produced during discovery. According to Defendant, however, he provided them to his attorney who, in turn, failed to disclose them because of the attorney's alleged conflict of interest with respect to Plaintiff. The conflict of interest allegedly arises from the fact that Defendant's former attorney had performed some legal work for Plaintiff on an unrelated matter about seven years earlier when he was part of another law firm.

**1. Defendant's Exhibit A.**

As noted, Exhibit A consists of three affidavits from individuals stating they experienced actual confusion between the parties' products. As noted, Defendant contends his attorney should have produced these documents to Plaintiff, but did not because of an alleged conflict of interest.

The three affidavits that make up Exhibit A, however, are not probative of whether a likelihood of confusion between the two marks exists because a "handful of declarations . . . submitted as evidence do not reliably indicate that [a product's] trade dress is likely to confuse 'an appreciable number of people.'" *Hansen Beverage Co. v. Nat'l Beverage Corp.* 493 F.3d 1074, 1080-81 (9th Cir. 2007) *vacated on other grounds* by 499 F.3d 923 (9th Cir. 2007)(citing *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1151 (9th Cir. 2002)(infringement exists only when a mark is likely to "confuse an appreciable number of people as to the source of the product").

Moreover, the record reflects that in its June 19, 2008, Interrogatory No. 11 and its June 19, 2008, Request for Production of Documents No. 18, Plaintiff requested Defendant, who was not represented at that time, to provide detailed descriptions of and any documents relating to any instances of actual confusion between Defendant's trademark and any of Plaintiff's goods or services. In his July 14, 2008, response to Plaintiff's Interrogatory No. 11, Defendant described one

instance of actual confusion between his trademark and Plaintiff's goods that occurred at a Dick's Sporting Goods store, and he stated he would submit "an appreciable number of affidavits from a number of individuals establishing actual confusion." Defendant, however, did not produce any affidavits or other responsive documents establishing actual confusion during the discovery period. The record reflects Defendant's attorney filed his Notice of Appearance on December 15, 2008, well after Defendant answered Plaintiff's Interrogatory and Request for Production. Accordingly, Defendant was at least as responsible as his counsel for providing Plaintiff with the material contained in Exhibit A, because the affidavits that make up Exhibit A are encompassed by Plaintiff's discovery requests.

Accordingly, even if Defendant's attorney could have or should have submitted Exhibit A in response to Plaintiff's Motion for Summary Judgment, such an error would be harmless because it would not have affected the outcome of the *Sleekcraft* analysis.

## **2. Defendant's Exhibit C.**

As noted, Exhibit C, Defendant's 2000-07 bank records, was only partly represented in the record before the Magistrate Judge, who had Defendant's bank records from 2005.

With respect to the Magistrate Judge's analysis of the *Sleekcraft* factors, these additional bank records are relevant only to establish Defendant's sales from his trademark, a fact

that can be important to determine strength of a trademark under the *Sleekcraft* analysis. See *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1179 (9th Cir. 1988) (sales can help demonstrate trademark strength). The strength of a trademark determines the scope of protection to which it is entitled. *Entrepreneur Media*, 279 F.3d at 1141. "This 'strength' of the trademark is evaluated in terms of its conceptual strength and commercial strength." *Goto.com*, 202 F.3d at 1207. With respect to conceptual strength,

the strongest marks--that is, those which receive the maximum trademark protection--are "arbitrary" or "fanciful." The weakest marks, entitled to no trademark protection, are "generic." In between lie "suggestive" and "descriptive" marks; suggestive marks have the greater strength of the two.

*Entrepreneur Media*, 279 F.3d at 1141 (internal citations omitted). Commercial strength may be demonstrated by commercial success, extensive advertising, length of exclusive use, and public recognition. *M2 Software, Inc. v. Madacy Entm't, Inc.*, 421 F.3d 1073, 1081 (9th Cir. 2005). In addition, "a suggestive or descriptive mark, which is conceptually weak, can have its overall strength as a mark bolstered by its commercial success." *Id.* A "lack of commercial strength[, however,] cannot diminish the overall strength of a conceptually strong mark so as to render it undeserving of protection." *Id.*

"A suggestive mark conveys an impression of a good but

requires the exercise of some imagination and perception to reach a conclusion as to the product's nature." *Brookfield*, 174 F.3d at 1058 n.19 (citation omitted). "Arbitrary . . . marks have no intrinsic connection to the product with which the mark is used . . . [and] consist[] of words commonly used in the English language." *Id.* (citation omitted).

The Magistrate Judge concluded Defendant's trademark was either suggestive or arbitrary on the scale of conceptual strength, but was commercially weak, and, therefore, found this *Sleekcraft* factor weighed in favor of Plaintiff.

The Court concludes the Magistrate Judge did not err to the extent she found Defendant's mark was arbitrary. The Magistrate Judge correctly concluded Defendant's trademark does not have any intrinsic connection to the products Defendant sells and is made up of commonly used words that require an inferential step to associate it with Defendant's products. Accordingly, Defendant's mark is arbitrary, and, therefore, is a strong mark. *Id.*

The Magistrate Judge did err, however, when she found the commercial weakness of Defendant's trademark eroded its conceptual strength because although the commercial success of a trademark can bolster a trademark's strength, a lack of commercial success does not weaken a strong mark. *See M2 Software*, 421 F.3d at 1081. Accordingly, the commercial success

of Defendant's trademark is of little relevance in determining its overall strength because it is conceptually strong in any event. *Id.* Defendant's complete 2003-07 bank records, which impact the *Sleekcraft* analysis only in terms of showing trademark strength through commercial success, therefore, do not add anything to the analysis.

Accordingly, even if Defendant's attorney could or should have submitted Exhibit C in response to Plaintiff's Motion for Summary Judgment, such an error would be harmless.

Nonetheless, even though the Court has concluded the Magistrate Judge erred with respect to her finding as to the strength of Defendant's trademark and, therefore, also erred when she found this *Sleekcraft* factor weighed in Plaintiff's favor, the Court concludes this factor, although weighing in Defendant's favor, does not tip the overall balance of the *Sleekcraft* factors in Defendant's favor. The strength of the trademark is not as important as the other *Sleekcraft* factors in this context because even though Defendant's mark is conceptually strong, "the ultimate question posed by the *Sleekcraft* analysis [is] the likelihood of confusion as to the source of the the product." *M2 Software*, 421 F.3d at 1081. Here the Magistrate Judge concluded the respective market presence and trademark recognition of the parties greatly impaired any likelihood of confusion between the origin of the parties' products because Plaintiff always included

its own identifying trademarks to establish the source of its products. See *Walter v. Mattel, Inc.*, 210 F.3d 1108, 1111 (9th Cir. 2000)(similarity between marks negated when accompanied by distinctive logo); *M2 Software*, 421 f.3d at 1082 ("[S]imilarity of marks has always been considered a critical question in the likelihood-of-confusion analysis."). The Magistrate Judge also found any potential for Plaintiff to capitalize on Defendant's mark was small, a conclusion that is correct on this record.

Thus, after reviewing the pertinent portions of the record *de novo* and Defendant's Objections, the Court does not find any error in the Magistrate Judge's ultimate recommendation that the Court grant summary judgment to Plaintiff as to its claim for a declaration of noninfringement and as to Defendant's Counterclaim for infringement based on those factors.

**C. The Magistrate Judge's finding that Defendant lacked standing to bring a Counterclaim under OUTPA.**

Defendant contends the Magistrate Judge erred when she found Defendant lacked standing to bring a claim under OUTPA because Defendant was not a consumer of Plaintiff's products. The Magistrate Judge noted "[c]ourts interpreting [O]UTPA have almost uniformly recognized that it is first and foremost a consumer protection statute." *CollegeNet, Inc. v. Embark.Com, Inc.*, 230 F. Supp. 2d 1167, 1178 (D. Or. Apr. 4, 2001).

The Court notes Defendant asserts for the first time that he is a consumer of several of Plaintiff's products, an assertion he

did not make in his Counterclaim nor in his Response to Plaintiff's Motion for Summary Judgment. Regardless of the untimeliness of Defendant's assertion or whether Defendant has standing as a consumer of Plaintiff's products to bring a Counterclaim, the Court agrees with the Magistrate Judge that Defendant has not adequately stated claims for unfair competition in violation of OUTPA. The standard for analyzing such a claim is the same as that for analyzing a claim arising under § 1125(a) for infringement, and the gravamen of both is "whether the [plaintiff] has created a 'likelihood of confusion.'" *Shakey's Inc. v. Covalt*, 704 F.2d 426, 431 (9th Cir. 1983)(citing 15 U.S.C. § 1125(a) and Or. Rev. Stat. § 646.608, *et seq.*). See also *Starbucks Corp. v. Lundberg*, No. 02-CV-948, WL 3183858, at \*13 (D. Or. Nov. 29, 2005)("Claims that arise under [§ 646.608, *et seq.*] for trademark infringement are analyzed using the same tests applied to trademark infringement claims under § 1125(a).").

This Court has already concluded the Magistrate Judge did not err when she found in her analysis of the *Sleekcraft* factors that there was no likelihood of confusion between Plaintiff's use of the phrase "prove it!" and Defendant's trademark and when she recommended this Court grant summary judgment to Plaintiff as to its claim for a declaration of noninfringement and as to Defendant's Counterclaim for infringement. Thus, based on the



same analysis and after reviewing the pertinent portions of the record *de novo* and Defendant's Objections, the Court does not find any error in the Magistrate Judge's findings as to Defendant's lack of standing to bring a claim under OUTPA and, therefore, as to her recommendation that this Court grant summary judgment to Plaintiff as to Defendant's Counterclaim under OUTPA.

**III. Defendant's Objections to the Magistrate Judge's August 17, 2009, Opinion and Order.**

On August 17, 2009, the Magistrate Judge issued an Opinion and Order in which she denied Defendant's Motion for Leave to Amend Opposition and File Motion to Dismiss.

**A. Defendant's Motions to Strike.**

On August 25, 2009, Defendant sent this Court a letter (#12) in which he stated he was "seeking clarification from the Court" and "objected to these findings" in the Magistrate Judge's August 17, 2009, Opinion and Order. Accordingly, the Court construed Defendant's August 25, 2009, letter as a timely Objection to the Magistrate Judge's August 17, 2009, Opinion and Order. In an August 28, 2009, Order, this Court directed the Clerk of Court to file Defendant's August 25, 2009, letter as an Objection and instructed Defendant to serve a copy of all filings on Plaintiff's counsel. The Court then received a second letter from Defendant dated August 27, 2009, in which Defendant requested this Court to disregard his August 25, 2009, letter. Defendant's August 27, 2009, letter did not include a certificate

of service.

On September 2, 2009, Defendant filed a Motion to Strike (#121) his August 25, 2009, letter in which he requested this Court to strike the August 25, 2009, letter and replace it with the August 27, 2009, letter. On September 9, 2009, Plaintiff indicated it did not object to Defendant's September 2, 2009, Motion to Strike.

On September 15, 2009, Defendant filed another Motion to Strike (#124) in which he requests this Court to strike all of the September 2, 2009, Motion to Strike except for Exhibit H attached thereto because the Court had filed an incomplete copy of his Motion that did not include Exhibit H. On September 22, 2009, Plaintiff indicated it did not object to Defendant's September 15, 2009, Motion to Strike to the extent Defendant was requesting the Court to strike a portion of its earlier Motion.

It appears to the Court that Defendant is requesting the Court to amend his September 2, 2009, Motion to Strike to include Exhibit H<sup>1</sup> because Exhibit H was inadvertently omitted and requests the Court to consider "all of the evidence in . . . his complete copy of his Motion (Doc. 121) [the September 2, 2009, Motion]." The Court notes, however, that Exhibit H was included with Defendant's September 2, 2009, Motion. To the extent

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<sup>1</sup> The Court notes this Exhibit H is not the same document as Defendant's Exhibit H filed with his Objections to the Magistrate Judge's Findings and Recommendations.

Plaintiff's September 15, 2009, Motion to Strike is a request to add Exhibit H, therefore, the Court concludes it is moot.

Because Plaintiff does not object to Defendant's September 2, 2009, Motion to Strike and because Defendant's August 25, 2009, letter is substantially the same as his August 27, 2009, letter, the Court grants Plaintiff's September 2, 2009, Motion to Strike and will construe Plaintiff's August 27, 2009, letter as Plaintiff's Objections to the Magistrate Judge's August 17, 2009, Opinion and Order.

**B. Defendant's August 27, 2009, Objections.**

Defendant's Motion for Leave to Amend Opposition and File Motion to Dismiss and his Objections to the Magistrate Judge's August 17, 2009, Opinion and Order were premised on the same grounds as his Objections to the Magistrate Judge's Findings and Recommendation: that his former attorney had a conflict of interest that resulted in his failure to file certain evidence. The Magistrate Judge denied Defendant's Motion on the ground that Defendant had not shown any conflict of interest existed. Moreover, the Magistrate Judge noted any conflict of interest on the part of Defendant's former attorney was more likely to be prejudicial to Plaintiff because the attorney could have gained access to information that was prejudicial to Plaintiff in this matter during the course of his prior representation of Plaintiff. As noted, the Magistrate Judge also concluded part of

the evidence identified by Defendant was before the Magistrate Judge when she considered Plaintiff's Motion for Summary Judgment and Defendant's Counterclaim and part of the evidence was not produced in discovery and, therefore, was inadmissible in any event.

As already discussed by this Court with respect to Defendant's Objection to the Magistrate Judge's Amended Findings and Recommendation and after reviewing the pertinent portions of the record *de novo* and Defendant's Objections, the Court does not find any error in the Magistrate Judge's Opinion and Order issued August 17, 2009.

#### **CONCLUSION**

For these reasons, the Court **ADOPTS as modified** Magistrate Judge Stewart's Amended Findings and Recommendations (#101). Accordingly, the Court **GRANTS in part** and **DENIES in part** Plaintiff's Motion (#42) for Summary Judgment as follows:

1. **GRANTS** Plaintiff's Motion as to its First Cause of Action for a declaration of noninfringement of a registered trademark;
2. **GRANTS** Plaintiff's Motion as to its Second Cause of Action for a declaration of non-false designation of origin;
3. **DENIES** Plaintiff's Motion as to its Third Cause of Action for cancellation of trademark registration;

4. **GRANTS** Plaintiff's Motion as to Defendant's First Counterclaim for trademark infringement;

5. **GRANTS** Plaintiff's Motion as to Defendant's Second Counterclaim for violations of OUTPA; and

6. **DENIES as moot** Plaintiff's Motion as to its fair use defense.

In addition, the Court **AFFIRMS** Magistrate Judge Stewart's August 17, 2009, Opinion and Order (#115).

IT IS SO ORDERED.

DATED this 7th day of October, 2009.

/s/ Anna J. Brown

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ANNA J. BROWN  
United States District Judge

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF OREGON  
PORTLAND DIVISION

ADIDAS AMERICA, INC.,

08-CV-91-BR

Plaintiff,

VERDICT, FINDINGS OF  
FACT, AND CONCLUSIONS  
OF LAW

v.

MICHAEL CALMESE,

Defendant.

DAVID K. FRIEDLAND

JAIME S. RICH

Lott & Freidland, P.A.  
355 Alhambra Circle, Suite 1100  
Coral Gables, FL 33134  
(305) 448-7089

STEPHAN M. FELDMAN

Perkins Coie, LLP  
1120 N.W. Couch St., 10th Floor  
Portland, OR 97209  
(503) 727-2058

Attorneys for Plaintiff

**MICHAEL CALMESE**

3046 N. 32nd Street, Unit 321  
Phoenix, AZ 85018  
(602) 954-9518

Defendant, *Pro Se*

**BROWN, Judge.**

Plaintiff adidas America, Inc., brought this action against Defendant Michael Calmese seeking, among other things<sup>1</sup>, cancellation of Defendant's "PROVE IT!" trademark (U.S. Trademark Registration No. 2,202,454) for use in connection with various sports apparel. In support of its claim for cancellation, Plaintiff contends: (1) Defendant committed fraud on the Patent and Trademark Office (PTO) in the process of obtaining and renewing his trademark; and (2) in the absence of fraud, Defendant's trademark should be void *ab initio* because Defendant falsely claimed his trademark was in use before he filed his use-based application.

In his Trial Memorandum, Defendant denies making false statements in support of his applications for his trademark and maintains he has used his trademark consistently and lawfully since 1995.

This matter was tried to the Court on November 2-3, 2010.

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<sup>1</sup> As noted below, all other issues in this case have been resolved in summary-judgment proceedings.

### **VERDICT**

The Court has weighed, evaluated, and considered the evidence presented at trial and has completed its deliberation. Based on its Findings of Fact and Conclusions of Law made herein pursuant to Federal Rule of Civil Procedure 52(a), the Court concludes Plaintiff has failed to meet its burden of proof as to each of its asserted bases for cancellation, and, therefore, the Court renders its Verdict in favor of Defendant on each of Plaintiff's asserted bases for cancellation of Defendant's trademark Registration No. 2,202,454.

### **PROCEDURAL BACKGROUND**

On January 18, 2008, in response to a cease-and-desist letter that Defendant issued to Plaintiff in May 2007, Plaintiff filed this action seeking a declaration of non-infringement of Plaintiff's trademark, a declaration of non-false designation of origin, and cancellation of Plaintiff's trademark. On February 12, 2008, Defendant filed his Answer in which he asserted, *inter alia*, two Counterclaims against Plaintiff for trademark infringement and for violation of Oregon's Unlawful Trade Practices Act.

On November 19, 2008, Plaintiff filed a Motion for Summary Judgment as to each of the three claims asserted by Plaintiff and both of the Counterclaims asserted by Defendant. On October 13,



2009, the Court adopted as modified Magistrate Judge Janice M. Stewart's Amended Findings and Recommendation in which the Court granted Plaintiff's Motion as to Plaintiff's First and Second Claims for non-infringement of Defendant's trademark and for non-false designation of origin. The Court also granted Plaintiff's Motion as to Defendant's First and Second Counterclaims for trademark infringement and for violations of Oregon's Unlawful Trade Practices Act. The Court denied Plaintiff's Motion with respect to Plaintiff's Third Claim for cancellation of Defendant's trademark, which, as noted, is the only remaining claim in this matter.

On November 2 and 3, 2010, Plaintiff's claim for cancellation of Defendant's trademark was tried to the Court. Three witnesses testified at trial: Vanessa Louise Backman, former intellectual-property counsel for adidas America, Inc.; Defendant Michael Calmese; and Girmar Demarcus Anwar, Defendant's business partner. Plaintiff submitted 37 exhibits at trial, and Defendant did not introduce any exhibits.

#### **SUMMARY OF PLAINTIFF'S CLAIMS**

As noted, Plaintiff contends Defendant's trademark should be cancelled either because he committed fraud on the PTO in the application and maintenance of his trademark or the trademark is void *ab initio* due to Defendant's failure to use the mark in

commerce before filing his use-based trademark application. With respect to its cancellation claim based on fraud, Plaintiff contends (1) on August 5, 1996, Defendant committed fraud in the initial application for the trademark he filed with the PTO when he stated the "PROVE IT!" mark had been used in commerce as early as November 1995; (2) on May 18, 1998, Defendant committed fraud when he submitted substitute cloth label specimens to the PTO bearing the "PROVE IT!" mark and declared they had been in use (affixed on each article of clothing listed in Plaintiff's registration) since the time of his original filing; and (3) on January 2, 2004, Defendant committed fraud when he stated in his Combined Declaration of Continuing Use and Incontestability that his "PROVE IT!" mark had been in continuous use for five consecutive years from the date of the registration for all goods listed in the registration.

In the alternative, Plaintiff contends the Court should cancel Defendant's trademark as void *ab initio* because Defendant had not made more than ornamental use of the "PROVE IT!" mark for each of the clothing types listed at the time he filed his original application for registration on August 5, 1996. Thus, Plaintiff contends Defendant did not meet the required use standard for an in-use trademark registration.

#### **STANDARDS**

Under 15 U.S.C. § 1119, the Court has authority to cancel a trademark registration. Specifically, a third party may seek cancellation of a trademark registration that was fraudulently obtained. 15 U.S.C. § 1064(3). An applicant for trademark registration or renewal commits fraud if he "knowingly makes false, material representations of fact in connection with his application," which is distinct from merely making false representations because fraud requires proof of an intent to deceive the PTO. *In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009). Proof of fraud is a heavy burden, and the "the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt should be resolved against the charging party." *Id.* (quoting *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (T.T.A.B. 1981)).

An "in-use" trademark registration requires the mark be used "in commerce" or it is void *ab initio*. *Aycock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1357 (Fed. Cir. 2009). In the context of trademarks,

the "use in commerce" requirement is met when a mark is (1) placed on the good or container, or on documents associated with the goods if the nature of the goods makes placement on the good or container impracticable, and (2) that good is then "sold or transported in commerce."

*Id.* (quoting 15 U.S.C. § 1127 (2006)). Section 1127 does not

prescribe a specific means for associating a mark with the goods it represents, but tags or labels affixed to the clothing products is generally an acceptable identifier of origin. See *In re Sones*, 550 F.3d 1282, 1287 (Fed. Cir. 2009). A "defendant's intent is not an element of a claim that a mark was not used on certain of the identified goods or services, nor is an enhanced standard of proof required." *Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 USPQ 2d 1696, 1697 (T.T.A.B. 2006). Thus, the Court applies a preponderance of the evidence standard to Plaintiff's claim that Defendant has not met the use-in-commerce requirement.

#### **PLAINTIFF'S CLAIM THAT DEFENDANT'S TRADEMARK IS VOID AB INITIO**

As noted, Plaintiff asserts two separate bases for cancellation of Defendant's trademark (fraud on the PTO and void *ab initio*) with separate burdens of proof (clear and convincing evidence and preponderance of the evidence, respectively). The Court will first address Plaintiff's void *ab initio* claim.

#### **I. Findings of Fact.**

The Court finds the following facts by a preponderance of the evidence:

1. On August 5, 1996, Defendant filed an application with the PTO to register "PROVE IT!" as a trademark.

Defendant represented his mark was first used in

commerce no later than November 1995 in connection with clothing: "namely men's and women's shirts, men's and women's t-shirts, men's and women's shorts, baseball hats, men's and women's jackets, socks, underwear and men's and women's underwear."

2. In December 1996 the PTO issued an Office Action in which it rejected Defendant's trademark application on the ground, *inter alia*, that Defendant's use of the "PROVE IT!" mark was merely ornamental.
3. In June 1997 Plaintiff responded to the PTO's Office Action and contended, *inter alia*, his use of the mark was not merely ornamental.
4. In July 1997 the PTO issued another Office Action denying Defendant's application on the ground that the use of the mark was ornamental and was not a source indicator.
5. On May 18, 1998, through his counsel, Defendant submitted a supplemental declaration in support of his trademark application. Defendant attached to the declaration a photocopy of four "PROVE IT!" clothing labels that were not shown to be attached to any article of clothing. In his declaration, Defendant attested "the specimen labels attached hereto were in use in interstate commerce at least as early as 5

August 1996."

6. On November 10, 1998, the PTO accepted Defendant's application for trademark and issued trademark registration number 2,202,454 for "PROVE IT!".
7. On January 2, 2004, Defendant filed a combined declaration to support his continuing use of the "PROVE IT!" trademark and his claim that the trademark had become incontestable. Defendant attested he had used the "PROVE IT!" trademark in commerce for five consecutive years on clothing: "namely men's and women's shirts, men's and women's T-shirts, men's and women's shorts, baseball hats, men's and women's jackets, underwear, and men's and women's sweatshirts . . . ." Defendant did not name "socks," which was an item included in connection with his original application and registration. In support of his declaration, Defendant submitted the same photocopy of the cloth "PROVE IT!" labels that he submitted to support his May 18, 1998, filing.
8. In May 2007 Defendant sent a cease-and-desist letter to Plaintiff in which Defendant asserted, *inter alia*, Plaintiff was infringing on his "PROVE IT!" trademark.
9. In response to Defendant's letter, Plaintiff began an investigation of Defendant's claim of infringement,

including an investigation of the legal validity of Defendant's trademark registration and Defendant's related business activity. Specifically, Plaintiff sought to verify Defendant's use in commerce of the "PROVE IT!" trademark by means of internet research and undercover attempts to purchase Defendant's products from internet retailers.

10. Plaintiff obtained a single t-shirt with the phrase "prove it on the field" from soccer.com. Defendant testified the shirt was not made by his company. Plaintiff also obtained a baseball hat ("PROVE IT!" on the front panel), a t-shirt ("PROVE IT!" on the front chest area), and a pair of men's and women's underwear ("PROVE IT!" on the front) from cafepress.com. None of the items had "PROVE IT!" hang tags or sewn-in labels, and each item had a tag or label identifying a source other than Defendant's trademark, such as "Hanes."
11. Plaintiff provided copies of internet archives from various websites that showed Defendant's clothing with the "PROVE IT!" logo, but the images did not show "PROVE IT!" hang tags on or cloth labels sewn into the articles of clothing advertised.
12. On January 18, 2008, Plaintiff filed its Complaint in this matter. During discovery, Defendant sought

production from Plaintiff of evidence to demonstrate his use in commerce of the "PROVE IT!" trademark.

Defendant did not produce any direct evidence of "PROVE IT!" hang tags on or cloth labels sewn into "PROVE IT!" articles of clothing despite providing evidence of articles of clothing bearing the "PROVE IT!" mark ornamentally.

13. Defendant testified he had cloth "PROVE IT!" labels sewn into each of the articles of "PROVE IT!" clothing that he had sold since at least the time of his trademark application.

14. Girmar Anwar attested he had purchased numerous articles of clothing from Defendant with the "PROVE IT!" trademark printed on labels that were sewn into the articles. He also attested he had seen Defendant's "PROVE IT!" clothing with sewn-in labels as of August 5, 1996, when Defendant applied for a trademark registration.

## **II. Conclusions of Law.**

Based on the foregoing Findings of Fact, the Court makes the following Conclusions of Law as to Plaintiff's claim that Defendant's trademark is void *ab initio*.

Plaintiff requests this Court to cancel Defendant's "PROVE IT!" trademark based on an inference that Defendant was not



making trademark use of the "PROVE IT!" mark as of the time of Defendant's application for trademark registration for "PROVE IT!". Essentially, Plaintiff rests its case on its inability to discover evidence since beginning its investigation in 2007 to corroborate Defendant's claim that he used sewn-in "PROVE IT!" labels in his clothing as of November 1995 and on its argument that Plaintiff's testimony to the contrary is not worthy of belief.

Against Plaintiff's inference-based contention, Defendant offers his sworn testimony and that of Girmar Anwar, which, if believed, is sufficient to refute Plaintiff's claim of cancellation. Although Plaintiff contends Defendant's testimony is not credible, Plaintiff's attempt to undermine Defendant's testimony that he was making trademark use of the "PROVE IT!" mark is based on a weak series of inferences that rests primarily on Defendant's failure to produce evidence to corroborate his testimony. Plaintiff, however, bears the burden of proof and must show that it is, in fact, more probably true than not that Defendant was not using the "PROVE IT!" mark in commerce at the time of Defendant's application to support its claim that the Court should declare the trademark void *ab initio*. See *Grand Canyon West Ranch*, 78 USPQ 2d at 1697.

The Court concludes a small-business owner's failure, fourteen years after the fact, to produce evidence of the type

Plaintiff seeks is not sufficient to support Plaintiff's contention that Defendant misrepresented the nature of the use of the "PROVE IT!" mark. Accordingly, the Court finds the evidence concerning Defendant's actual trademark use of the "PROVE IT!" mark in this matter is, at best, in equipoise. As such, the Court concludes Plaintiff has failed to carry its burden of proof as to its claim that Defendant's "PROVE IT!" trademark is void *ab initio*.

**PLAINTIFF'S CLAIM THAT DEFENDANT'S TRADEMARK SHOULD BE CANCELLED  
FOR FRAUD**

**I. Findings of Fact.**

The Court incorporates its Findings of Fact as to Plaintiff's "void *ab initio*" argument and notes Plaintiff's grounds to support a finding that Defendant made fraudulent misrepresentations are based on the same evidence offered to support Plaintiff's claim that Defendant did not make trademark use of the "PROVE IT!" mark. Although Plaintiff contends Defendant committed acts of fraud subsequent to his initial application with the PTO, Plaintiff's claim regarding Defendant's fraudulent intent, which must be proved "to the hilt" by clear and convincing evidence, relies almost exclusively on the fact that Defendant has failed to corroborate the statements he made to the PTO regarding his use in commerce of the "PROVE IT!"

trademark in support of his trademark application and continuation. See *In re Bose*, 580 F.3d at 1243.

## **II. Conclusions of Law.**

The Court concludes there is no rational way to differentiate between the evidence offered to support Plaintiff's void *ab initio* claim and the claim of fraud. Based on the foregoing, the Court is unable to find any fact by clear and convincing evidence as required to support Plaintiff's fraud claim. Plaintiff's evidence, therefore, is insufficient to prove Defendant acted with a fraudulent intent to deceive the PTO. Although the Court is unable to make the findings necessary for Plaintiff to prevail, the Court notes it would likewise be unable to rule affirmatively in Defendant Calmese's favor if he had a burden of proof. Defendant's credibility in these proceedings is not sufficient to persuade this trier of fact that any particular contention is true. On this weak record, however, the Court is unwilling to find Defendant perjured himself when he offered testimony contradicting Plaintiff's inference-based arguments. Accordingly, the Court concludes Plaintiff's fraud claim fails because Plaintiff has failed to meet its burden of proof.

## **CONCLUSION**

For these reasons, the Court enters its Verdict against Plaintiff on each of Plaintiff's asserted bases for cancellation

of Defendant's "PROVE IT!" trademark (U.S. Trademark Registration No. 2,202,454).

The Court directs Plaintiff's counsel to submit no later than December 1, 2010, a proposed judgment consistent with this Verdict and disposing of all the matters previously resolved in the summary-judgment proceedings. Defendant's objections to the proposed judgment, if any, are due no later than December 10, 2010. After the judgment is entered, the Court will set a schedule for the parties to petition the Court for attorneys' fees and costs.

IT IS SO ORDERED.

DATED this 19<sup>th</sup> day of November, 2010.

/s/ Anna J. Brown

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ANNA J. BROWN  
United States District Judge